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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,506	04/19/2004	Terrance M. Sharp	PAT 56676A-2	1938
27510	7590	05/19/2005	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			GOFF II, JOHN L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/826,506	SHARP, TERRANCE M.
	Examiner	Art Unit
	John L. Goff	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 April 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.  
 4a) Of the above claim(s) 22-34 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 and 35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 19 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 9/21/04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21 and 35, drawn to a tape application head, classified in class 156, subclass 522.
  - II. Claims 22-34, drawn to a method of applying tape, classified in class 156, subclass 264.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as applying webs other than tape.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Tiep Nguyen on 5/3/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21 and 35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

*Drawings*

6. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the draftsperson objections noted on the attached PTO-948. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Claim Objections*

7. Claims 7, 9, 17, and 19 are objected to because of the following informalities: In claims 7 and 17, line 1 delete "side" as there is no antecedent basis for said "side" cutting assembly. In claims 9 and 19 there is no antecedent basis for "said guide roller". It appears "said guide roller" should read -- means for receiving tape from a tape supply --, and this is the interpretation given by the Examiner. It is suggested to delete "said guide roller" and insert therein -- means for receiving tape from a tape supply -- to overcome the objection. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **It is noted the limitations in the claims regarding the material worked upon by the apparatus and the intended use of the apparatus do not further limit the claims other than the apparatus must be capable of performing the intended use and must include any structural limitations required by the intended use (See MPEP 2114 and 2115).**

10. Claims 1-6, 9, 12-16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Reis et al. (U.S. Patent 5,536,342).

Reis et al. disclose a robotic web applicator including a web application head (20 of Figure 1) capable of applying tape. Reis et al. teach the web application head comprises an idler/guide roller (44 of Figure 1) capable of receiving a tape from a tape supply, a nose (39 of Figure 1) capable of applying a tape to a substrate when the application head is moved along a substrate, and a cutting assembly (56 of Figure 1) including a blade (58 of Figure 2) movable in a direction not substantially towards a substrate the web application head is working on capable of cutting tape. Reis et al. teach a hub (26 of Figure 1) capable of mounting a roll of tape and idler/guide rollers (42a and 42b of Figure 1) capable of guiding the tape from the hub to the tape application head. Reis et al. further teach the web application head comprises a motorized web drive unit (50, 52, and 54 of Figure 1) capable of driving tape through the application head, an outfeed roller (48 of Figure 1) capable of guiding a removable tape backing to a disposal system,

a guide roller (46 of Figure 1) between the cutting assembly and the nose capable of guiding tape from the cutting assembly to the nose, and a controller (19 of Figure 1) capable of activating the cutting mechanism at an appropriate position (Figures 1 and 2 and Column 3, lines 15-25 and Column 4, lines 5, 38-67 and Column 5, lines 1-61 and 55-58).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reis et al. in view of Goodhue (U.S. Patent 5,714,034).

Reis et al. is described above in full detail. Reis et al. are silent as to the particular means for indication to the controller the cutting mechanism should be activated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include on the web application head taught by Reis et al. feed rate sensors for working with the controller to determine when the cutting mechanism should be activated as was well known in the art as shown for example by Goodhue wherein only the expected results would be achieved.

Goodhue is exemplary in the art of the well known use of a controller and feed rate sensor to activate a cutting mechanism (Column 6, lines 31-37).

Art Unit: 1733

13. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reis et al. in view of either one of Gruber et al. (U.S. Patent 4,980,011) or Pagett et al. (U.S. Patent 5,709,162).

Reis et al. is described above in full detail. Reis et al. are silent as to using a compliance cylinder to apply pressure to the nose, it being noted Reis et al. teach any means may be used (Column 4, lines 40-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the means to apply pressure to the nose taught by Reis et al. a compliance cylinder, e.g. a compliance air cylinder and brake assembly, as was well known in the art as shown for example by either one of Gruber et al. or Pagett et al. for accurately pressing the nose.

Gruber et al. and Pagett et al. are exemplary in the art of a compliance cylinder, e.g. including a compliance air cylinder and brake assembly, for accurately controlling the distance of a pressing member, e.g. tape application head nose (Column 3, lines 5-7 of Gruber et al. and Column 6, lines 35-39 of Pagett et al.).

14. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reis et al. in view of Gruber et al.

Reis et al. is described above in full detail. Reis et al. are silent as to using a vacuum disposal system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the disposal system taught by Reis et al. a vacuum system to avoid having to spool removable tape backing as was well known in the art and shown for example by Grubber et al.

Grubber et al. is exemplary in the art of a tape applicator head including a vacuum disposal system cooperating with a tape drive unit to dispose of a removable tape backing (Column 3, lines 50-53).

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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